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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,585	02/24/2005	Esko Hotti	11001.148	2954

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EXAMINER

ABRAMOWITZ, HOWARD E

ART UNIT PAPER NUMBER

1762

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/525,585

Applicant(s)

HOTTI, ESKO

Examiner

Howard E. Abramowitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/24/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-7 in the reply filed on 12/21/05 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim requires a drying step using a scavenging agent to dry the surface of the article being treated. However, the only scavenging agent disclosed is water vapor, it is not possible to dry a surface using water vapor as the vapor will only condense on the surface and further wet the surface not remove water that is all ready present.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1, the phrase "which is formed of one or more compounds *and possible additives*" is indefinite as it is unclear whether the additives are present or not. Clarification is necessary. For the purpose of this office action it will be assumed that the additives are not present as they are not required.

Referring to claim 2, the phrase "is formed in the point of application from at least two fractions" is indefinite as the point of application is never defined. Further BIRCH-TAR is a liquid not a vapor yet claim 1 requires bringing the surfacing material to a gaseous state, the vapor phase is the CO, H₂ and CO₂. For the purpose of examination the surfacing material will be assumed to be formed and then brought to the part to be treated in any manner as it is not clear the manner that is intended from the claim language. The limitation of the birch tar being in the vapor phase will thus be taken to mean that at some point in the processing the birch tar is vaporized but for the surfacing step the birch tar will be assumed to have recondensed.

Referring to claim 4, the phrase "can comprise" is indefinite as it does not specifically claim that the part comprises. For the purpose of examination the word can will be assumed to be removed.

Referring to claim 5, the scavenging agent is used to dry the surface however the only disclosed scavenging agent is water vapor, which inherently cannot dry the surface, therefore one of ordinary skill would not be able to give a definite meaning to

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the term scavenging as described by the specification. For the purpose of this office action the term scavenging will be taken to mean a treatment with water as that is what is disclosed in the specification.

Referring to claims 3, 6 and 7, they are rejected for being dependent on rejected claims.

Claim Objections

Claim 6 is objected to because of the following informalities: the phrase "in order to bring the surfacing to the surface" should read "in order to bring the surfacing material to the surface". Appropriate correction is required.

Claim 2 is objected to because of the following informalities: BIRCH-TAR (I) and CO(g), H₂(g), CO₂(g) should not be in parenthesis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 74003741 B ('741).

Referring to claim 1, '741 teaches a method for the surface treating of a metal, iron to prevent rusting, in which the surface treatment is performed in a surfacing

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chamber, using a surfacing material. The surfacing material is brought to a principally gaseous state, this occurs during the distilling process of deciduous wood. The surfacing material is then recondensed and brought into contact with the metal surface and permitted to react with the surface being treated. The surfacing material in one example is run through the circulation system of a boiler where there is a through flow of the surfacing material connected to an exhaust, the exhaust would be the exit point of the through flow (abstract, page 2).

Referring to claim 2, the surfacing material is formed from a dry distillation of Birch wood, thus during the forming of the surfacing material birch-tar liquid and gaseous CO, H₂ and CO₂ would inherently be present as they are products of the dry distillation.

Referring to claim 3, as the surfacing material is formed from the same dry distillation process this process would inherently form surfacing material that exists partially in the solid state.

Referring to claim 4, as mentioned above the internal surface of a boiler can be the surface that is being coated.

Referring to claim 5, '741 discloses diluting the treatment solution with water (abstract). This would be an aqueous treatment which would read on the above determined definition of a scavenging stage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over '741 in view of Miller et al. (US Patent No. 5,648,416).

Referring to claims 6 and 7, '741 teaches all of the features of the claims except it does not teach to apply a potential to the surface to increase the attraction of the surfacing material to the surface. However, Miller teaches that it is desirable to apply a potential to the surface of a part being coated to attract the coating material to the part in order to help evenly coat irregularly shaped articles with little loss of coating material (column 18 lines 22-31). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify '741 to apply a voltage to the surface being treated so as to increase the attraction between the surfacing material and the surface being treated as suggested by Miller et al. with an expectation that the coating will be evenly applied and have little loss of coating material.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard E. Abramowitz whose telephone number is 571-272-8557. The examiner can normally be reached on monday-friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on 571-272-1423. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HEA

TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER

